

EXPEDITED PROCEDURE – EXAMINING GROUP 2179

IN 09/576,754

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Douglas R. Adler et al.	Examiner:	Joshua D. Campbell
Serial No.:	09/576,754	Group Art Unit:	2179
Filed:	May 23, 2000	Docket No.:	2050.028US1
Title:	METHOD AND SYSTEM FOR DYNAMIC FONT SUBSETTING		

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

In response to the Final Office Action mailed June 28, 2005, Applicants hereby request a Pre-Appeal Brief Review. This Request is being filed along with a Notice of Appeal.

REMARKS

Claims 1-20 and 22-35 currently are pending in the application.

For the reasons given below, Applicants believe that the rejections of record are clearly not proper. Accordingly, Applicants respectfully request that a pre-appeal brief review be conducted by the Office, in which the application's prosecution history and the below remarks be considered.

Summary of Relevant/Recent Prosecution:

In an Office Action mailed 1/27/2005 (no paper number indicated), the Examiner rejected claims 1-20 and 22-35 under 35 U.S.C. § 103(a). On 4/27/2005, Applicants filed a response to the 1/27/2005 Office Action. In the 4/27/2005 Response, Applicants amended certain claims and argued that a *prima facie* case of obviousness had not been established to support the rejections. In the Final Office Action (no paper number indicated), the Examiner repeated the rejections of claims 1-20 and 22-35 (pp. 2-16), and further responded (pp. 16-19) to Applicants' arguments presented in the 4/27/2005 Response.

Basis for Review:

In the rejections of record, one or more essential elements to establish a *prima facie* case of obviousness are omitted. This assertion is explained in detail, below, in the order that the claims were rejected in the 6/28/2005 Office Action.

Claims 15-18, 20, 22-23 and 25-27:

In the 6/28/2005 Office Action, items 4-11, claims 15-18, 20, 22-23 and 25-27 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Collins et al. (U.S. 5,781,714) in view of Lipton (U.S. 5,940,581). Applicants respectfully traverse.

1) A *prima facie* case of obviousness has not been established because the rejections of record omit one or more elements of Applicants' claims 15-18, 20, 22-23, and 25-27.

Applicants request that the review panel refer to Applicants' 4/27/2005 Response at pages 13-15, sections "Traverse 1," "Traverse 1, Part A," and "Traverse 1, Part B." Applicants

believe that it is clear that neither Collins et al., Lipton, nor their combination disclose the following elements of Applicants' claims 15-18, 20, 22-23, and 25-27:

"... responsive to the sending of the first request for the electronic content, the electronic device receiving modified electronic content from the intermediate network device over the first network, wherein the modified electronic content is created responsive to the first request . . ."

(claims 15-18 and 20)

OR

"a pre-determined encoding scheme used to encode the set of glyphs . . ." (claims 15-18, 20, 22-23, and 25-27).

2) A prima facie case of obviousness has not been established because a proper motivation for combining Collins et al. and Lipton has not been shown.

Applicants request that the review panel refer to Applicants' 4/27/2005 Response at pages 15-16, sections "Traverse 2" and "Traverse 3." In the 6/28/2005 Office Action, on page 17, the Examiner references Lipton (col. 2, lines 20-23) as providing a statement of motivation, and also states that "another possible motivation for creating the subsets on the fly would be to conserve storage space by not storing each of the subsets ahead of time." Applicants believe that the Lipton reference (col. 2, lines 20-23) does not provide the appropriate motivation to combine, and that the latter motivation, quoted above, is a mere conclusory statement of subjective belief. Applicants repeat its contention that the Office Action has not provided objective evidence for a suggestion or motivation to combine the references.

Claims 1-14 and 28-35:

In the 6/28/2005 Office Action, items 12-31, claims 1-14 and 28-35 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Simon et al. (U.S. 6,065,008) in view of Collins et al. and further in view of Lipton. Applicants respectfully traverse.

1) A prima facie case of obviousness has not been established because the rejections of record omit one or more elements of Applicants' claims 1-14 and 28-35.

Applicants request that the review panel refer to Applicants' 4/27/2005 Response at pages 17-20, sections "Traverse 1," "Traverse 1, Part A," "Traverse 1, Part B," and "Traverse 1,

Part C.” Applicants believe that it is clear that neither Simons et al., Collins et al., Lipton, nor their combination disclose the following elements of Applicants’ claims 1-14 and 28-35:

“... the intermediate network device scanning the requested electronic content to identify one or more sets of glyphs in the requested electronic content . . . ; creating one or more glyph sub-sets for the one or more identified sets of glyphs, wherein the one or more glyph sub-sets include . . . glyphs identified in the requested electronic content . . .” (claims 1 and 31)

OR

“... a pre-determined encoding scheme used to encode the set of glyphs . . .” or “... one or more pre-determined encoding schemes . . .” (claims 1, 8, 28)

OR

“... responsive to the sending of the first request, receiving modified electronic content from the intermediate network device over the first network, wherein the modified electronic content is created responsive to the first request . . .” (claim 34).

2) A prima facie case of obviousness has not been established because a proper motivation for combining Simons et al., Collins et al., and Lipton has not been shown.

Applicants request that the review panel refer to Applicants’ 4/27/2005 Response at pages 21-22, sections “Traverse 2” and “Traverse 3.” In the 6/28/2005 Office Action, on pages 18-19, the Examiner references Lipton (col. 2, lines 20-23) as providing a statement of motivation, and also states that “another possible motivation for creating the subsets on the fly would be to conserve storage space by not storing each of the subsets ahead of time.” Applicants believe that the Lipton reference (col. 2, lines 20-23) does not provide the appropriate motivation to combine, and that the latter motivation, quoted above, is a mere conclusory statement of subjective belief. Applicants repeat its contention that the Office Action has not provided objective evidence for a suggestion or motivation to combine the references.

Claims 19 and 24:

In the 6/28/2005 Office Action, items 32-33, claims 19 and 24 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Collins et al. in view of Lipton as applied to claims 8, 15 and 22, and further in view of Simon et al. Applicants respectfully traverse for the reasons

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given in Applicants' 4/27/2005 Response at pages 22-23, sections "Traverse 1," "Traverse 2," and "Traverse 3."

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney (480) 538-1735 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,


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Date of Deposit: September 6, 2005

This paper or fee is being deposited on the date indicated above with the United States Postal Service pursuant to 37 CFR 1.10, and is addressed to The Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.